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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,355	03/22/2004	Tatsuya Maruyama	119173	9004

25944 7590 12/12/2006

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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT PAPER NUMBER

1756

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,355

Applicant(s)

MARUYAMA ET AL.

Examiner

Martin J. Angebrannndt

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1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/8/04 & 3/22/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/22/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 6-16 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Minabe et al. '038.

The manufacture of cell type media where flakes of the polymers are placed on a glass substrate and covered with another glass substrate and heat pressing these to form the optical recording media [0148]. The use of the polymers 1-4 shown in tables 1 and 2 [0123] and the polymeric blends to form cells where the spacing is 100, 180 or 500 microns is disclosed. [0149]. Substrate materials can be polycarbonate, glass, PET, acryl sheets of the like [0137].

The substrates are considered protective layers

4. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minabe et al. '038.

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With respect to the embodiments not anticipated by the cited examples above, it would have been obvious to one skilled in the art to modify the cited examples by using other substrates, disclosed, such as polycarbonate, acryl or the like with a reasonable expectation of forming a useful holographic recording medium.

5. Claims 1-4 and 6-16 are rejected under 35 U.S.C. 102(a) as being fully anticipated by Minabe et al. JP 2004-059897 (machine translation attached).

The manufacture of cell type media where flakes of the polymers are placed on a glass substrate and covered with another glass substrate and heat pressing these to form the optical recording media [0123,0126]. The use of the polymers 1-4 shown in tables 1 and 2 [0106-0110] and the polymeric blends to form cells where the spacing is 100, 180 or 500 microns is disclosed. [0127-130]. Substrate materials can be polycarbonate, glass, PET, acryl sheets of the like [0121].

The substrates are considered protective layers

6. Claims 1,2 and 11-16 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Minabe et al. '095.

Useful azopolymers bounded by the claims and the formation of recording layers have thicknesses of 0.1 to 2 mm and formed by spin coating, casting or hot pressing on a substrate is disclosed. [0055-0056].

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being fully anticipated by JP 2001-294652 (machine translation provided)

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The polyester azo obtained in example 1 is coated to form a layer of 100 microns in thickness (0.1 mm) on p glass substrate.[0118] The use of hot pressing is disclosed. [0072]. The thickness can be 0.1 to 5 mm [0700]. Useful substrates include glass and polymers. [0070].

8. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. '318.

Matsumoto et al. '318 teaches a liquid crystalline polymer which may be shaped using methods including the hot press method in thicknesses up to 1 mm. (11/31-41).

It would have been obvious to use disclosed processes to form the polymeric liquid crystal in thicknesses of 0.1 to 1 mm with a reasonable expectation of forming a useful LC article. The examiner holds that it inherently can be used to recording optical information.

9. Claims 1,2 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-294652 (machine translation provided)

In addressing the embodiments not anticipated by the reference, it would have been obvious to one skilled in the art to modify the process of preparing the cited example by using other techniques disclosed as forming layers of the desired thicknesses such as hot pressing with a reasonable expectation of forming a useful holographic recording medium

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No.

11/037359 (US 2005/0265134) in view of JP 2001-294652 (machine translation provided)

It would have been obvious to one skilled in the art to modify the claimed invention of claims 1-16 of copending Application No. 11/037359 (US 2005/0265134) which recite polymers having mesogenic groups to use those disclosed by JP 2001-294652 (machine translation provided) with a reasonable expectation of forming a useful optical recording medium.

This is a provisional obviousness-type double patenting rejection.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

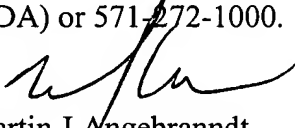
Kawano et al. 153, Minabe et al. '085, Yoshizawa et al. '256, Furuki et al. '388, Kawano et al. 984, Kawano et al. '873 and Fukuda et al. '693 teach polymers bound by the recitation of claim 1, but in thinner layers.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Martin J Angebrannt
Primary Examiner
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12/8/2006